

REMARKS

Claims 1-35 were pending in the current application. Applicant has amended claims 1, 17, 19-22 and 24-27. Claims 17, 19-22, and 24-27 have been amended in part or in full to remove use of a), b) and c) designators and not for reasons related to patentability. Reexamination and reconsideration of all pending claims are respectfully requested.

§ 112

The Office Action rejected claims 11-36 based on the alleged lack of support for the concept of “initiation of an interface on the first device occurring at the second device.” (Office Action, p. 2, point 3). Applicant first does not agree with this characterization of the claim language. However, Applicant has amended independent claims 11, 19 and 29 to recite “providing a communication interface on a first electronic device coupled to a communication network that when initiated by a user provides an indication at said first electronic device of any second electronic device available and configured to establish a communications path directly with the first electronic device” (claim 29, with similar language in claims 11 and 19) shown in the specification at, for example, at page 14, lines 14-25 describing networking wizardry and the GUI: “the networking wizardry, through the GUI, is able to locate local resources and determine the necessary information needed to set up a communication path between the device where the GUI is located and the other local resources on the communication network. The user need only look at a list of available resources for connection and select the remote device needed.” By this amendment, Applicant submits that claims 11-36 comply with the written description requirement and that all claims, as amended, satisfy 35 U.S.C. §112.

§ 102

The Office Action rejected claims 1 and 5-10 under 35 U.S.C. § 103 based on Blight, U.S. Patent 6,785,542 (“Blight”).

Applicant has amended claim 1 to recite “a plurality of electronic devices coupled to said communication network, at least one of said plurality of electronic devices comprising a power button and a selector, the selector engageable to initiate a user initiated communication interface that when enabled presents network connectivity information specific to an associated electronic device implementing said communication interface....” As noted in the Office Action, and as previously discussed by Applicant, the selector is distinctly different from a power button. The Office Action characterizes the “selector” as being shown by “powering on the device” or requesting an HTML page. However, neither of these represents a selector engageable to manually initiate a user initiated communication interface separate and distinct from a power button. The selection of an HTML page, such as by “http://localhost/” (for example) at col. 14, l. 60 of Blight, does not represent a selector “engageable to initiate a user initiated communication interface that when enabled presents network connectivity information specific to an associated electronic device implementing said communication interface....” Thus neither the power button of Blight nor the request for an HTML page anticipates “at least one of said plurality of electronic devices including a power button and a selector...” as recited. Claim 1 is therefore not anticipated by Blight, and claims depending from allowable claim 1 are also allowable as they include limitations not shown in the cited reference.

§ 103

The Office Action rejected claims 2-4 under 35 U.S.C. § 103 based on Blight in view of Gaucher, U.S. Patent 6,175,860 (“Gaucher”).

Gaucher is relied on for “centrally monitoring initiations of computer interfaces within a communications network....” Office Action, p. 8. Gaucher does not show what is discussed above with respect to claim 1, namely “at least one of said plurality of electronic devices comprising a power button and a selector, the selector engageable to initiate a user initiated communication interface that when enabled presents network connectivity information specific to an associated electronic device implementing said communication interface....” The absence of this limitation from Blight and Gaucher renders claims 2-4, which depend from allowable claim 1, also

allowable as non-obvious. Thus claims 2-4 are allowable over the cited references, alone or in combination.

Applicant also disagrees that one of ordinary skill in the art would have a reason to combine the features disclosed in the Blight and Gaucher references in the manner suggested in the Office Action. Applicant submits that a combination of Blight and Gaucher is unreasonable, and such a combination is using hindsight to reconstruct the claimed invention.

The PTO has the burden of establishing a prima facie case of obviousness under 35 USC §103. The Patent Office must show that some reason to combine the elements with some rational underpinning that would lead an individual of ordinary skill in the art to combine the relevant teachings of the references. *KSR International Co. v. Teleflex Inc.*, No. 04-1350, 550 U.S. ____ (2007); *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). Therefore, a combination of relevant teachings alone is insufficient grounds to establish obviousness, absent some reason for one of ordinary skill in the art to do so. *Fine* at 1075. In this case, the Examiner has not pointed to any cogent, supportable reason that would lead an artisan of ordinary skill in the art to come up with the claimed invention.

None of the references, alone or in combination, teaches the unique features called for in the claims. It is impermissible hindsight reasoning to pick a feature here and there from among the references to construct a hypothetical combination which obviates the claims.

It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. [*citation omitted*]

In re Gordon, 18 USPQ.2d 1885, 1888 (Fed. Cir. 1991).

A large number of devices may exist in the prior art where, if the prior art be disregarded as to its content, purpose, mode of operation and general context, the several elements claimed by the Applicant, if taken individually, may be disclosed.

However, the important thing to recognize is that the reason for combining these elements in any way to meet Applicant's claims only becomes obvious, if at all, when considered from hindsight in the light of the application disclosure. The Federal Circuit has stressed that the "decisionmaker must step backward in time and into the shoes worn by a person having ordinary skill in the art when the invention was unknown and just before it was made." *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1566 (Fed. Cir. 1987). To do otherwise would be to apply hindsight reconstruction, which has been strongly discouraged by the Federal Circuit. *Id.* at 1568.

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

W.L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553 (Fed. Cir. 1983). Therefore, without some reason in the references to combine the cited prior art teachings, with some rational underpinnings for such a reason, the Examiner's conclusory statements in support of the alleged combination fail to establish a prima facie case for obviousness. *See, KSR International Co. v. Teleflex Inc.*, No. 04-1350, 550 U.S. ____ (2007) (obviousness determination requires looking at "whether there was an apparent reason to combine the known elements in the fashion claimed...", citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness," KSR at 14).

The alleged reasoning supporting the combination is apparently for "simple [setup,] operation and cost..." Office Action, pp. 8-9. This is not a reason supporting the combination of Blight with Gaucher, but instead a conclusion used to justify choosing references based on aspects presented in the claims. It is always beneficial to improve setup, operation, cost, efficiency, and so forth, but the question is what reasoning would have been used by one to take the teachings of Blight and

modify them in a manner consistent with Gaucher. Here, no such reason has been articulated. Conclusory reasoning such as that presented is nothing more than improper hindsight reconstruction of the invention, and for this further reason, claims 2-4 are allowable over the cited references.

Based upon the totality of the foregoing, Applicant respectfully submits that claims 1, 11, 19 and 29, as amended, are allowable over the references of record, and all claims dependent therefrom are also allowable as they include limitations not present in the cited references.

Accordingly, it is respectfully submitted that all claims fully comply with 35 U.S.C. § 103

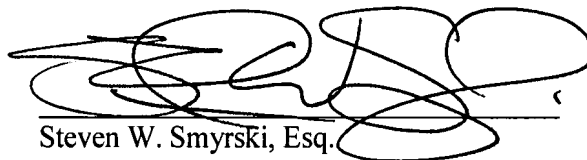
CONCLUSION

In view of the foregoing, it is respectfully submitted that all claims of the present application are in condition for allowance. Reconsideration of all of the claims, as amended, is respectfully requested, and allowance of all the claims at an early date is solicited.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Should it be determined for any reason an insufficient fee has been paid, please charge any insufficiency to ensure consideration and allowance of this application to Deposit Account 08-2025.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Smyrski', with a horizontal line underneath it.

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